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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Robert E. Smith III

Serial Number: 10/826,883

Filed: 04/16/2004

For: JUNCTION PLATE FOR SUBSEA
HYDRAULIC COUPLINGS§
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Confirmation No. 1438

Examiner: David Bochna

Group art unit: 3679

Atty Docket No. 221-0078US

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF(i) Real party in interest.

The real party in interest is the assignee of the entire interest in the invention and application,
National Coupling Company, Inc., a Texas corporation.

(ii) Related appeals and interferences.

There are no related appeals or interferences.

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CERTIFICATE OF TRANSMISSION

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By:

Christopher D. Keirs
Christopher D. Keirs Reg. No. 32,248

Date:

31 August 06

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(iii) Status of claims.

Claims 1 – 4 and 9 – 18 are pending in the application.

Claims 11 – 18 are allowed.

Claim 3 is objected to.

Claims 1, 2, 4, 7, 9 and 10 are rejected.

Claims 1, 2, 4, 9 and 10 are being appealed.

(iv) Status of amendments.

An amendment filed after the final rejection was entered for purposes of appeal in the Advisory Action mailed 06/27/2006.

(v) Summary of claimed subject matter.

The subject matter claimed in independent claim 1 is illustrated in plan view in Figure 1 and in cross-section in Figure 2. The reference characters in the drawings corresponding to the claimed elements are inserted parenthetically in claim 1, below. References to the specification by paragraph number are shown in square brackets.

1. A junction plate (10) [¶0025] for hydraulic couplings (12) [¶0025; ¶0026] comprising:
 - a cam actuator (16) [¶0030; ¶0032];
 - a drive mechanism [¶0029] comprising a gear train (22, 24, 26) [¶0029; ¶0036] coupled to the cam actuator (16); and,
 - a cam carrier (28) [¶0029] coupled to the drive mechanism and having at least one cam follower (30) [¶0029].

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(vi) Grounds of rejection to be reviewed on appeal.

Whether claims 1, 2, 4 and 9 – 10 are anticipated under §102(e) by U.S. Patent No. 6,595,552 to Mortari.

Whether claim 1 is anticipated under §102(e) by U.S. Patent No. 6,805,382 to Jennings.

(vii) Argument.

Legal authority

The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements.¹

"Similarity or identity such as will negate novelty and constitute anticipation is determined by reference to the language of the claim of the patent or application. In this respect, the inquiry as to anticipation is symmetrical with the inquiry as to infringement of a patent."²

Federal Circuit decisions repeatedly emphasize that anticipation is established only if (1) all the elements of an invention, as stated in a patent claim,³ (2) are identically set forth,⁴ (3) in a

¹ See *Crucible, Inc. v. Stora Kopparbergs Bergslags AB*, 594 F. Supp. 1249, 226 USPQ 36, 40 (W.D. Pa. 1984), *aff'd in part & remanded in part sub nom. Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1034 (1987) (citing Treatise); *Studiengesellschaft Kohle mbH v. Dart Indus.*, 549 F. Supp. 716, 216 USPQ 381 (D. Del. 1982), *aff'd*, 726 F.2d 724, 220 USPQ 841 (Fed. Cir. 1984) (citing Treatise); *In re Certain Caulking Guns*, 223 USPQ 388 (U.S. Int'l Trade Comm'n 1984).

² *Chisum on Patents* §3.02[1]

³ *Nystrom v. Trex Co.*, 374 F.3d 1105, 1117, 71 USPQ2d 1241 (Fed. Cir. 2004) ("A patent is invalid as anticipated if every limitation in a claim is found in a single prior art reference."); *Merck & Co. v. Teva Pharmaceuticals USA, Inc.*, 347 F.3d 1367, 1372, 68 USPQ2d 185 (Fed. Cir. 2003) ("An 'anticipating' reference must describe all of the elements and limitations of the claim in a single reference, and enable one of skill in the field of the invention to make and use the claimed invention."); *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664 (Fed. Cir. 2003), *reh'g and reh'g en banc denied*, 348 F.3d 992, 68 USPQ2d 1760 (Fed. Cir. 2003) ("A patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention."); *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306,

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single prior art reference.⁵

Federal Circuit decisions reject any standard of "substantial identity."⁶ In *Jamesbury Corp. v.*

1321, 66 USPQ2d 1429 (Fed. Cir. 2003), *cert. denied*, 540 U.S. 982 (2003) ("Anticipation under 35 U.S.C. § 102 requires that a single prior art reference disclose each and every limitation of the claimed invention."); *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120, 65 USPQ2d 1051 (Fed. Cir. 2002) ("A single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. *See, e.g., In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ('the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it').");

⁴ *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120, 65 USPQ2d 1051 (Fed. Cir. 2002) ("Invalidity based on 'anticipation' requires that the invention is not in fact new. *See, e.g., Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ('lack of novelty (often called "anticipation") requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee').");

⁵ *Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co.*, 308 F.3d 1167, 1188, 64 USPQ2d 1545 (Fed. Cir. 2002) ("In order to succeed on its anticipation defense, [an accused infringer] was required to prove by clear and convincing evidence that every limitation of [a patent owner's] asserted claims was contained, either expressly or inherently, in a single prior art reference."); *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 1335, 63 USPQ2d 1374 (Fed. Cir. 2002) ("As we have repeatedly stated, anticipation requires that each limitation of a claim must be found in a single reference."); *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917 (Fed. Cir. 2002) ("A patent is invalid for anticipation when the same device or method, having all of the elements contained in the claim limitations, is described in a single prior art reference.").

⁶ *See Key Pharmaceuticals v. Hercon Laboratories Corp.*, 161 F.3d 709, 718-19, 48 USPQ2d 1911, 1919 (Fed. Cir. 1998) (claim to a "drug in adhesive" transdermal patch requiring a dosage of at least 2.5 mg/day is not anticipated by a reference showing a patch with a dosage calculated to deliver a maximum of 2.0 mg/day; the infringer argued that the prior art reference "would merely have to be increased in size by 25 percent to deliver 2.5 mg/day, and ... this is inherently taught by ... the ... reference. However, as the trial court's findings indicate, these assertions lack the kind of support in the record needed for proof of invalidity by clear and convincing evidence."); *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) (the district court correctly found a patent's claims not anticipated but it "did not articulate the correct legal standard when it stated that to invalidate a patent the prior reference must 'give the same knowledge and the same directions' as the challenged patent." ; "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."); *Credle v. Bond*, 25 F.3d 1566, 1578, 30 USPQ2d 1911, 1921 (Fed. Cir. 1994) (a reference that discloses a "flexible" element does not anticipate a claimed invention that requires that the element be "flexibly" secured to an object. "Nothing ... prevents the existence of a perfectly secure, inflexible bond between the end of a flexible member and another inflexible object"); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991) ("Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference.... There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.").

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Litton Industrial Products, Inc.,⁷ the Federal Circuit held that a jury instruction that a patent is invalid for lack of novelty if the prior art "disclosed substantially the same things" was erroneous. It noted that a verdict of invalidity for anticipation should be overturned when reasonable persons could not find the evidence clear and convincing that all the claim limitations were met by the prior art reference in question.

Emphasizing "the rigors of anticipation," the Federal Circuit, in *Motorola, Inc. v. Interdigital Technology Corp.*,⁸ held that a jury's verdict that one patent claim was anticipated by a prior art reference could not stand because the reference lacked a limitation the claim required. An expert's conclusory testimony based on the state of the art could not "supplant the requirement of anticipatory disclosure in the prior art reference itself."⁹

Rejection of claims 1, 2, 4 and 9 – 10 under §102(e) as being anticipated by U.S. Patent No. 6,595,552 (Mortari).

In the final Office Action, the Examiner contends that element 20 of Mortari is a cam actuator and that element 14 is a cam carrier with at least one cam follower 15.

The coupling device described in Mortari has no cams, cam actuators, cam carriers or cam followers. Mortari simply uses a gear-driven, threaded shaft which engages an internally-threaded bushing ["bush"] to effect movement of the supporting plates.

Finally, the movable plate 13 is provided with a threaded member for coupling to the head 15 of the shaft 14, which is constituted by an internally threaded bush 39 which is contained, with a slight play for orientation, within

⁷ *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985), *later appeal* 839 F.2d 1544, 5 USPQ2d 1779 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 828 (1988).

⁸ *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 43 USPQ2d 1481 (Fed. Cir. 1997).

⁹ 121 F.3d at 1473, 43 USPQ2d at 1490.

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a cover-shaped support 40 rigidly coupled to the movable plate 13. [col. 3; lines 10-15]

When the two threaded elements 15 and 39 are close one another, the actuator 24 is deactivated and the motor 20 is activated, turning the shaft 14, which screws onto the bush 39, and allowing the connection of the connectors 11. [col. 3; lines 26-29]

Each of claims 1, 2, 4 and 9 – 10 requires a cam carrier having at least one cam follower. Since these elements are not found in the coupling device described in Mortari, none of these claims is anticipated by Mortari.

Rejection of claim 1 under §102(e) as being anticipated by U.S.
Patent No. 6,805,382 (Jennings).

The Examiner contends that “components 22 and 24 work to translate rotational motion of 22 into longitudinal motion of plate 12, making 22 and 24 a gear train.”

There is no gear or gear train in the flowline connector described in Jennings. A “gear” is commonly understood to be and is defined as “a toothed wheel” [Merriam-Webster’s *Collegiate Dictionary*, 10th ed.]. There is no toothed wheel in the device described in Jennings. Element 22 in Jennings is a jack screw. Element 24 is a jack nut.

Jack screws 22 extend from an upper end of frame 12 and are rotatably secured in landing bases 16. The upper ends of jack screws 22 extend through jack nuts 24 rigidly attached to the upper surface of frame 12. In the preferred embodiment, each arm 14 has one of the landing bases 16 and one of the jack screws 22. Each jack screw 22 secures to landing base 16 and extends upward through an upper end of arm 14 through jack nut 24 attached to an upper surface of arm 14 as shown in FIG. 2. Jack screws 22 have polygonal upper ends. [col. 2; lines 56-65]

Claim 1 requires a gear train. Lacking a gear train, Jennings cannot anticipate claim 1.

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There being a clear deficiency in the prima facie case in support of the rejection – limitations in the claims are not met by the cited references – it is submitted that claims 1, 2, 4, 9 and 10 are in condition for allowance.

Dependent claims

Dependent claim 2

Claim 2 additionally requires that the cam actuator of claim 1 comprises a handle. The Examiner contends that element 34 of Mortari comprises a handle.

Element 34 in Mortari is a screw. [col. 2; line 59] Moreover, screw 34 is in the interior of the device (see Fig. 2) and therefore unavailable as a handle which may be grasped.

Dependent claim 4

Claim 4 requires that the cam actuator of the junction plate recited in claim 1 comprises a crank. The Examiner contends that cam actuator 20 of Mortari comprises a crank (“motor shaft connected to gear 19”).

A “crank” is “a bent part of an axle or shaft or an arm keyed at right angles to the end of a shaft by which circular motion is imparted to or received from the shaft or by which reciprocating motion is changed into circular motion or vice versa.” [Mirriam-Webster’s *Collegiate Dictionary*; 10th ed.] Element 20 of Mortari is a hydraulic motor [col. 2; line 39]. No element of the device described in Mortari is apparent which is “a bent part of an axle or shaft or an arm keyed at right angles to the end of a shaft” – i.e., there is no crank in the Mortari reference.

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Claim 9 requires that the cam follower of the junction plate recited in claim 1 be integral with the cam carrier. The Examiner contends that the cam follower 15 of Mortari is integral with the cam carrier 14.

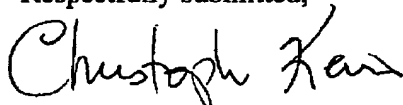
Element 15 in Mortari is not a cam follower but rather the "threaded head" of shaft 14 [col. 2; line 32]

Dependent claim 10

Claim 10 further requires the junction plate recited in claim 1 to comprise a handle for manipulating the junction plate. The Examiner contends that element 11 of Mortari comprises a handle – "cylinder 11 provides a nice cylindrical surface for one to grab onto."

Element 11 of Mortari is a connector [col. 2; lines 26-27] which projects from frame 21 at right angles (Fig. 2). It is submitted that, while any projection might be grasped, a cylindrical projection at right angles to a plate would provide a poor handhold inasmuch as one's hold is likely to slip along the axis of the cylinder. Thus, connectors 11 of Mortari cannot reasonably be considered "handles."

Respectfully submitted,



Christopher D. Keirs
Reg. No. 32,248
Attorney for Applicant
Wong Cabello Lutsch Rutherford & Brucculeri LLP
20333 State Hwy. 249 Suite 600
Houston, Texas 77070
832 446-2400
Fax: 832 446-2424
ckeirs@counselip.com

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(viii) Claims appendix.

1. A junction plate for hydraulic couplings comprising:
 - a cam actuator;
 - a drive mechanism comprising a gear train coupled to the cam actuator; and,
 - a cam carrier coupled to the drive mechanism and having at least one cam follower.
2. A junction plate as recited in claim 1 wherein the cam actuator comprises a handle.
4. A junction plate as recited in claim 1 wherein the cam actuator comprises a crank.
9. A junction plate as recited in claim 1 wherein the cam follower is integral with the cam carrier.
10. A junction plate as recited in claim 1 further comprising a handle for manipulating the junction plate.

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(ix) Evidence appendix.

NONE

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(x) Related proceedings appendix.

NONE